

REMARKS/ARGUMENTS

STATUS OF CLAIMS

Claims 1, and 70-11 were previously pending. Claims 85-88, 90, and 93 are cancelled by this amendment. Claims 80-82 and 96 are amended by this amendment. Thus, claims 1, 70-84, 89, 91-92, 94-111 are currently pending.

Claims 84, 92, 100, 101, 106, and 107 are indicated as “objected to” on the Office Action Summary, *i.e.*, page 1 of the Office Action (paper no. 0512). These claims are indicated “as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form, including all of the limitations of the base claim and any intervening claims.” Paper No. 0512, page 4, first paragraph.

This objection is respectfully traversed. Claims 92 and 107 are independent claims, not dependent claims. Thus there is no reason to object to these claims. Claim 92 and 107 should therefore be indicated as allowable, without further amendment or modification.

Claims 84, 100, and 106 are dependent upon independent claim 92. Thus these claims are dependent upon an allowable claim, not upon a rejected base claim. Similarly, claim 101 is dependent upon independent claim 107, not upon a rejected base claim.

Thus each of claims 84, 92, 100, 101, 106, and 107 should be indicated as allowable without further amendment or modification.

THE AMENDMENTS

Claim 96 is amended herein, to change the recitation of “a tissue of interest” to “a cardiac tissue.” It is respectfully submitted that this is supported throughout the application as originally filed and puts the application in better condition for allowance or appeal because it corresponds to the scope which the PTO acknowledges as enabled.

Claims 80-82 are amended so that the antecedent basis of the claims is clear and consistent with their base claim, as amended.

The Rejection of Claims 1, 70-83, 85-91, 93-99, 102-105 and 108-111 Under 35 U.S.C. §112, first paragraph

Claims 1, 70-83, 85-91, 93-99, 102-105 and 108-111¹ stand rejected because the specification is allegedly “enabling for *ex vivo* methods of nucleic acid delivery and direct injection of nucleic acids, [but] does not reasonably provide enablement for all *in vivo* methods of delivery.” Paper No. 0512, page 2, paragraph 2. Moreover, after evaluating the declaration of Dr. Donahue, the PTO has concluded that “the data shown support that Applicant [sic; the application] is enable[d] for *in vivo* perfusion into cardiac tissue, in addition to the *ex vivo* and direct injection methods previously discussed.” Paper No. 0512, page 3, lines 18-20.

In view of this conclusion regarding the evidence of enablement provided by the specification and the declaration of Dr. Donahue, applicants have amended claim 96 so that it recites delivery of nucleic acids to cells in a cardiac tissue and recites perfusion through vasculature of cardiac tissue. It is respectfully submitted that the scope of claim 96 now corresponds to that which the PTO acknowledges as enabled.

Because claims 1, 70-77, 80-83, 89, 91, 94-95, 97, 99, 102-103, 105, and 108-111 are ultimately dependent from claim 96 and therefore narrower than claim 96, these claims too should be within the scope that the PTO acknowledges as enabled. Thus on the basis of the amendment to claim 96 to recite “cardiac tissue,” applicants respectfully request that the rejection be withdrawn as it applies to claims 1, 70-77, 80-83, 89, 91, 94-97, 99, 102-103, 105, and 108-111.

Rejected claims that are not ultimately dependent from claim 96 are claims 78-79, 98, and 104. Each of these claims is ultimately dependent on claim 92. Claim 92 is not a rejected claim. Claim 92 is directed to *ex vivo* administration of nucleic acid. The PTO has explicitly acknowledged that this subject matter is enabled in the final office action. Paper No. 0512, page 2, second paragraph. The PTO has indicated that claim 92 is

¹ Claims 85-88, 90, and 93 have been cancelled and will not be discussed further.

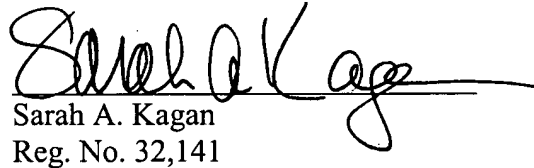
directed to allowable subject matter. See Office Action, Paper No. 0512, at page 4, first paragraph. Because dependent claims are by definition narrower than the claims from which they depend, each of claims 78-79, 98, and 104 should be enabled for the same reason as claim 92, the claim from which they depend. The PTO has provided no independent reasons for rejection of claims 78-79, 98, and 104. Thus withdrawal of the rejection of these claims is respectfully requested.

Allowance of all pending claims is respectfully requested.

Respectfully submitted,

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By:


Sarah A. Kagan
Reg. No. 32,141

Banner & Witcoff, Ltd.
Customer No. 22907